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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,060	07/09/2001	Roger Collins	05545.P001	9276
7590	08/16/2005		EXAMINER	
Thomas C. Webster BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP Seventh Floor 12400 Wilshire Boulevard Los Angeles, CA 90025-1026			WAMSLEY, PATRICK G	
			ART UNIT	PAPER NUMBER
			2819	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/902,060  
Filing Date: July 09, 2001  
Appellant(s): COLLINS ET AL.

**MAILED**  
**AUG 16 2005**  
**GROUP 2000**

\_\_\_\_\_  
Mark L. Watson  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed on 07/19/2004.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

Appellant declared that there are no related appeals and interferences related to the present appeal that will directly affect, be directly affected by, or have a bearing on the decision in the pending appeal.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant declared that claims stand or fall together.

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

**(10) Grounds of Rejection**

The following grounds of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 11, 13, 21, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 806,858 to Szlam, hereafter Szlam.

For claim 1, Szlam provides a method comprising the steps of identifying a block of data within an electronic mail message [Szlam's method includes e-mail as well as other data formats] also found in a stored message; generating a pointer [see col. 14, lines 19-32]; replacing the block of data with the pointer [this occurs when Szlam creates a Composite Call Object <sup>TM</sup>]; and transmitting the message to a wireless device [Szlam lists numerous methods of communication, including wireless] having a stored message [pointers identify data used during prior communication transactions]. Claim 11 restates these limitations in system format. For claim 21, Szlam replaces data blocks with pointers to achieve more efficient transmission of information.

For claims 3, 13, and 24, Szlam decompresses e-mail by inserting blocks of data corresponding to specified pointers.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-9, 14-19, and 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Admitted Prior Art, hereafter APA, in view of Szlam.

APA is hereby defined as conventional e-mail techniques presented in the disclosure. For claims 4, 14, and 25, prior art e-mail includes subject fields. For claims 5, 15, and 26, conventional e-mail designates responses to previous e-mails [typically with RE:]. For claims 6, 16, and 27, one or more alternate compression techniques are applied to conventional e-mail, as described on pages 2-3. For claims 7, 17, and 28, it's well known to replace common strings with code words; applicant describes LZW compression with pointers on page 3. For claims 8, 18, and 29, conventional e-mails include address domains. For claims 9, 19, and 30, the use of six bits per character appears to be conventional. No critical reason for the selection of this number of bits has been presented.

APA lacks the concept of generating a pointer identifying data blocks in previous e-mails, replacing blocks with that pointer, and then transmitting the message to a wireless device storing the previous e-mails. As described for the 102 rejection above, Szlam provides these features. At the time of the invention, it would have been obvious to one of ordinary skill in the art to have applied Szlam's teachings to APA.

The motivation would have been to provide data compression, as described by Szlam on lines 37-48 of column 3.

These rejections were set forth in a prior Office Action, mailed on 02/18/2004.

**(11) Response to Arguments**

Appellant argues that there is no disclosure in Szlam of identifying a block of data within an electronic mail message. In response, Szlam provides pointers to information so that a complete trace of relevant and previously used information, such as prior e-mails, can be quickly and easily reassembled [col. 6, lines 21-26]. Szlam uses pointers to identify the location of information [col. 14, lines 19-22], corresponding to the recited blocks of data within prior e-mails. Moreover, Szlam's stored information can be the actual data, part of the data, or linkage information [col. 15, lines 34-37], thereby enabling compression of a prior e-mail.

Appellant argues that Szlam does not identify a previous electronic mail message which contains a block of data found in a new electronic mail message. In response, Szlam uses a pointer (reference element) to locate all data associated with an initial message, a Sales Order transaction [col. 28, lines 18-25]. As defined by Szlam, such information is transmitted and received in a series of e-mails. Even if this movement of data is not explicitly described, it is implicitly present.

Szlam's invention is clearly related to the sending or receipt of e-mails [col. 14, lines 39-40], using pointers to identify, and then search for, previous recorded messages. Stored information includes linkage information to the actual data [col. 15, lines 36-37], as a replacement for the actual data.

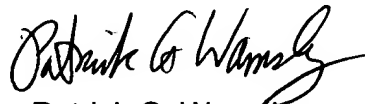
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Szlam also can specify that a follow-up e-mail is needed [col. 24, lines 48-50], thereby linking an initial e-mail to a later message. Instead of sending a complete copy of a prior message, Szlam locates and identifies information [col. 5, lines 43-52], corresponding to the claimed blocks of data, storing and transferring linkage information to more efficiently use e-mails. Thus, a retained collection of pointers [col. 4, lines 39-40] allows a system to identify and search for blocks of data in stored e-mails.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Primary Examiner


  
Patrick G. Wamsley

August 4, 2005

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